

REMARKS

Claims 1-22 are pending in the application. In the Final Office Action dated November 28, 2005, the Examiner maintained the rejection of claims 1-6, 8-13, 15-20, and 22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,335,760 ("Sato") in view of U.S. Pat. No. 6,778,607 ("Zaccarin"). Further, the Examiner maintained the rejection of claims 7, 14, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Sato in view of Zaccarin and U.S. Pat. No. 5,604,494 ("Murakami"). In this Amendment, claims 1, 8, and 15 have been amended. Applicants respectfully request reconsideration and withdrawal of the rejections in light of the amendments to the claims and the following remarks.

I. It Is Improper to Combine Sato and Zaccarin

It is improper to combine Sato and Zaccarin due to the fact Sato and Zaccarin teach away from their combination. See MPEP §§ 2141.02 and 2145. Sato and Zaccarin teach away from each other due to the fact Sato teaches an *efficient* method to produce a *single signal* with a resolution *dependant on a single display* in communication with the Sato system where Zaccarin teaches a method for encoding a signal at different bit rates *independent of the multiple displays* in communication with the Zaccarin system.

In the Office Action dated November 28, 2005, the Examiner admitted that Sato is limited to providing a signal to a single display, but submits that Zaccarin teaches an added benefit of providing varying bitrates to a plurality of users at the same time. Applicants disagree that providing varying bitrates to a plurality of users at the same time is an added benefit to Sato. In fact, providing varying bitrates to a plurality of users at the same time defeats the purpose of Sato.

The object of Sato is "to provide an image reproduction device in which a resolution or gradation of an image can be changed in accordance with an indicated performance of a display." (Col. 1, lines 35-38.) Only one signal is produced in Sato to permit "an original high resolution image to be efficiently indicated on a variety of

displays, of varying inherent resolutions. . .” (Col. 8, lines 55-57.) Altering Sato to provide varying bitrates to a plurality of users independent of a display in communication with the Sato system teaches away from the efficient method of Sato.

Further, it is improper to modify Sato in a manner that renders Sato unsatisfactory for its intended purpose or changes its principle of operation. See MPEP §§ 2143.01 and 2145. The object of Sato is “to provide an image reproduction device in which a resolution or gradation of an image can be changed in accordance with an indicated performance of a display.” (Col. 1, lines 35-38.) Modifying Sato to produce multiple image signals independent of a display in communication with Sato defeats the purpose of Sato and would render components of Sato meaningless. For example, Sato discloses a resolution recognition unit. Sato increments a low-resolution image signal to a high-resolution image signal until the resolution of the image signal is equal to or greater than the inherent resolution of a display as determined by the resolution recognition unit. If Sato were modified to always provide varying bitrates to a plurality of users, there would be no purpose for the resolution recognition unit.

Due to the fact Sato and Zaccarin teach away from their combination, and due to the fact the proposed modification to Sato would render Sato unsatisfactory for its intended purpose or change the principle operation of Sato, it is improper to combine Sato and Zaccarin. Applicants respectfully request reconsideration and withdrawal of the rejection to the claims.

II. The Proposed Combination of Sato and Zaccarin Does Not Render the Independent Claims Unpatentable

Even if Sato and Zaccarin are improperly combined, the proposed combination of Sato and Zaccarin does not render the amended independent claims unpatentable. Amended independent claims 1, 8, and 15 are directed to a method and system that provides a plurality of levels of compression using a **single compression engine**. The currently-claimed invention discloses a method and system that provides a first and second DCT-encoded signal, wherein the coefficients of the second DCT-encoded signal has less coefficient bits than the coefficients of the first DCT-encoded signal. The

coefficients of the second DCT-encoded signal are created by removing at least one lesser-significant bit from each of the coefficients of the first DCT-encoded signal. Sato and Zaccarin fail to disclose a single compression engine operable to provide a first and second DCT-encoded signal as provided in the claims at substantially the same time.

As discussed above, Sato teaches an efficient method to produce a single image signal with a resolution dependant on a single display in communication with the Sato system. The Sato system begins with a low-resolution signal and increments the resolution to a high-resolution signal. The Sato system does not produce image signals of varying resolutions at one time. The Examiner relies on Figures 3 and 4 of Zaccarin for providing a plurality of encoded video streams. However, Zaccarin does not resolve how the Sato system that is limited to producing one image signal at a time can be modified to provide multiple signals at one time providing different resolutions. Presumably, to produce multiple signals at one time providing different resolution, it would be necessary to combine multiple Sato systems, resulting in **multiple compression engines**. In contrast, each of the amended independent claims recite that a single compression engine provides the first and second DCT-encoded signal at substantially the same time.

Due to the fact Sato discloses a compression engine that may only provide an image signal at one resolution at any time, and Zaccarin fails to disclose how Sato could be modified such that a single compression engine may provide multiple image signals at different resolutions at one time, any combination of Sato and Zaccarin necessarily cannot render the amended independent claims unpatentable. Applicants respectfully request the withdrawal of the rejection to claims 1-6, 8-13, 15-20, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Sato in view of Zaccarin.

III. The Proposed Combination of Sato, Zaccarin and Murakami Does Not Render the Independent Claims Unpatentable

Even if Sato and Zaccarin are improperly combined, the proposed combination of Sato, Zaccarin, and Murakami does not render the amended independent claims unpatentable. Murakami is directed to an encoding/decoding apparatus that alleviates

errors after repeatedly encoding/decoding a digital signal. Murakami does not disclose or suggest providing a plurality of levels of compression like the currently-claimed invention or reconcile how Sato could be modified such that a single compression engine may provide multiple image signals at different resolutions at one time.

Due to the fact that neither Zaccarin or Murakami fail to disclose how Sato could be modified such that a single compression engine may provide multiple image signals at different resolutions at one time, any combination of Sato, Zaccarin, and Murakami necessarily cannot render the independent claims, or any claims that depend on the independent claims, unpatentable.

IV. Applicants Request a Telephone Interview

Applicants respectfully request a telephone interview with the Examiner to discuss the rejection to the claims and the references cited in the Office Action dated November 28, 2005. When the Examiner is prepared to discuss the current Amendment, Applicants respectfully request the Examiner contact Scott W. Brim at (312) 321-4240 to schedule a telephone interview.

V. CONCLUSION

In view of the foregoing remarks, Applicants submit that the pending claims are in condition for allowance. Reconsideration is therefore respectfully requested. If there are any questions concerning this Response, the Examiner is asked to phone the undersigned attorney at (312) 321-4200.

Respectfully submitted,



Scott W. Brim
Registration No. 51,500
Attorney for Applicants

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200